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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**Appeal No. 2005-1602**

**Application No. 09/734,635**

**SUPPLEMENTAL EXAMINER'S ANSWER**

1. Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on August 10, 2005 **for further consideration of a rejection**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

a. Appellant alleges unexpected results. The results submitted with the declaration of December 12, 2002 show unexpected results with respect to compounds B1 and B2. However, the Examiner maintains the data presented therein is not commensurate in scope with the appealed claims. There are hundreds of compounds that fall within the scope of formula 1 of claim 1 when the Ar<sub>1</sub> group is varied and R<sub>1</sub> is not. Additionally, when Ar<sub>1</sub> is held consistent, there are over 60 possibilities for R<sub>1</sub> alone. There are thousands of compounds that fall within the scope of claim 1 when both Ar<sub>1</sub> and R<sub>1</sub> are varied. Compounds B1 and B2 both contain an unsubstituted benzoyl group for R<sub>1</sub>. The data presented suggests compounds B1 and B2 have improved sensitivity over compound A of Laridon however it is not clear if this improved sensitivity is true for the thousands of compounds that fall within the scope of

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formula 1 of claim 1. Additionally, Appellant prefers compound B1. See Example 1. In response to Appellants position that substituted aryl was selected because unsubstituted compounds are not encompassed by the instant claims, the Examiner disagrees.

According to claim 1, Ar<sub>1</sub> can be a C<sub>3</sub>-C<sub>9</sub> heteroalkyl group that is unsubstituted when R<sub>1</sub> is acetyl. Further the Examiner is suggesting comparisons with compounds that are structurally similar to compound A of Laridon. For Example suitable additional comparisons to compound A of Laridon would have been to use C<sub>6</sub> aryl group substituted with C<sub>1-20</sub> alkyl groups or halogen groups for Ar<sub>1</sub>. To adequately show unexpected results for the genus of compound that are within the scope of claim 1, the Examiner would at least expect to see the compound of Laridon compared with inventive compounds wherein R<sub>1</sub> is an alkanoyl, benzoyl and an oxycarboxyl and inventive compounds wherein Ar<sub>1</sub> is an aryl group having more than six and up to twenty carbon atoms and a heteroaryl group having three to nine carbon atoms. One would expect to see these inventive compounds substituted and unsubstituted as well. For at least these reasons, the Examiner strongly disagrees that the comparison of compounds B1 and B2 give a clear indication that the thousands of compounds of the present invention exhibit good performance over the broad scope. Compound B1 and B2 are structurally different from each other and from the thousands of compounds also within the scope of formula 1 of claim 1. For Example, compounds B1 and B2 are structurally different from compounds wherein Ar<sub>1</sub> is a C<sub>3</sub>-C<sub>9</sub> heteroaryl which is substituted with a benzoyl that is substituted with one or more NR<sub>5</sub>R<sub>6</sub> groups. It is not clear if the compounds with such drastically different structural groups would give the same unexpected results since different substitutents and different chemical groups

have strong influences on the chemical properties of compounds. Again, compound B1 is also a preferred compound. See Example 1 of the present specification.

b. Appellant argued the photopolymerization system used in comparison to the photopolymerizable system of example 31 of Laridon is as close as possible and appropriate. Upon further consideration, the Examiner agrees this comparison is adequate. This comparison yields results that appear to be significant however it is not clear if similar results are obtainable for the thousands of compounds within the scope of formula 1 since Appellant only compared two preferred compounds comprising identical R<sub>1</sub> groups. In regard to instant claim 5, Appellants argue that the said claim is narrower in scope than claim 1 and the said declaration shows unexpected results over the claimed invention. The Examiner strongly disagrees. The inventive compounds of the said declaration (B1 and B2) both exemplify R<sub>1</sub> being an unsubstituted benzoyl substituent having 6 carbon atoms. Claim 5, as written, specifically requires R<sub>1</sub> to be a C<sub>2</sub>-C<sub>4</sub> alkanoyl which is entirely different from the benzoyl group of the inventive compounds in the declaration. Appellants have offered no comparisons in the declaration of compounds having a C<sub>2</sub>-C<sub>4</sub> alkanoyl as R<sub>1</sub> as required in instant claim 5. Therefore, the examiner cannot make a direct comparison between the claimed invention of instant claim 5 and the cited prior art. The examiner maintains the position that Laridon teaches that R<sup>6</sup> can be selected from the group including benzoyl, phenylsulphonyl, acetyl, or ethoxycarbonyl. Specifically, when R<sup>6</sup> of Laridon is ethoxycarbonyl, the limitations of a C<sub>2</sub>-C<sub>4</sub> alkanoyl as set forth in instant claim 5 are met.

c. The Examiner is not questioning the support of the scope of claim 1 or claim 5. However Appellants have only compared two inventive compounds to the prior art. It is not clear if the thousands of compounds, specifically the 30 different compounds cited by Appellant, give the same results as the two compared in the declaration. It is again noted that Appellants have offered no comparisons in the declaration of compounds having C<sub>2</sub>-C<sub>4</sub> alkanoyl as R<sub>1</sub> as required in instant claim 5.

d. The Examiner is not suggesting Appellants make and compare compounds that are not taught in the prior art. The Examiner suggested making the system of Example 1 of Laridon and comparing it to the same system wherein the ketoxime (compound A) is replaced with inventive aldoxime compounds of formula 1. However, upon further consideration the Examiner agrees the comparison of the declaration is appropriate and involves the closest prior art however, the comparison fails to show unexpected results for a significant number of compounds within the scope of formula 1 of claim 1.

2. The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any

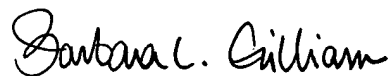
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request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.


Respectfully submitted,



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

bg  
November 7, 2005

Conferees  
Cynthia H. Kelly   
Patrick Ryan 